

Appellant's Reply Brief on Appeal
S/N: 09/893,789

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Marcos Nogueira NOVAES.

Serial No.: 09/893,789

Group Art Unit: 2162

Filed: June 29, 2001

Examiner: Ly, A.

For: **METHOD AND SYSTEM FOR SPATIAL INFORMATION RETRIEVAL
FOR HYPERLINKED DOCUMENTS**

Commissioner of Patents
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF ON APPEAL

Sir:

Appellant respectfully herein replies to the Examiner's Answer mailed on November 23, 2007. Appellant does not herein modify the arguments of the Appeal Brief, and the following comments are additional to those in the Brief, as based on comments and clarifications in the Examiner's Answer.

ISSUE 1: THE STATUTORY SUBJECT MATTER REJECTION

As best can be deciphered from the wording of paragraph 1 on page 4 of the Examiner's Answer, the Examiner's concern is that of using mathematical processing, as based upon *Benson*. However, Appellant submits that the present invention is clearly distinguished from the facts of *Benson* because whatever underlying mathematics is involved in the present invention is not being claimed in the abstract. Rather, the underlying mathematics, to the extent that mathematics is included in the claims, is strictly directed to the practical application of a database navigation technique.

Stated slightly differently, the present invention is not preempting a mathematical algorithm, as the Court considered to be happening in *Benson*. Rather, the present invention is directed to a practical application that utilizes some underlying mathematical calculations. This application is inherently real-world, since it involves an electronic database. As Appellant noted in his Appeal Brief, even the USPTO considers an electronic database as “useful, tangible and concrete”, and the present invention is directed to a navigation method within such electronic database.

Relative to paragraph 2 on page 4 of the Answer, wherein the Examiner imports a meaning from the specification into the claim language, Appellant respectfully submits that the Examiner's interpretation simply ignores the plain meaning of the claim language itself. To the extent that the claim wording is construed to include transmissions of any sort, Appellant respectfully submits that independent claims 45 and 47 actually recite: “A computer-readable medium tangibly embodying a program of recordable, machine-readable instructions executable by a digital processing apparatus to perform a computer-implemented method of”

As such, because of the wording “tangibly embodying”, this description clearly addresses at least the media that are physically embodied, including at least memory embodiments on a computer, such as a hard drive or RAM, that are storing the program either for actually executing the method of the program or for storing the program for potentially execution at some future time. Likewise, this wording also covers the tangible embodiments of a standalone diskette, such as a floppy or CD, as based upon *In re Beauregard*, 53 F.3d 1583 (Fed Cir, 1995), and subsequently-issued US Patent No. 5,710,578 that issued on January 20, 1998, to Beauregard et al.

The Examiner's position seems to be based upon the possibility that the claim language additionally covers the actual transmission of the computer program, which the Examiner declares to be non-statutory subject matter without providing a citation to support this position.

In response, Appellant respectfully submits that neither Appellant nor Appellant's representative nor the USPTO nor the Examiner knows yet whether transmission of patented methods are protected against transmission via, for example, the Internet or Docket YOR920010315US1 (YOR.292)

wireless transmission, simply because this issue has never been resolved in the Courts or in Congress. In the interim, it is up to the Courts and Congress to make up new law, not the Examiner.

Second, it is brought to the Board's attention that the plain language of the claim is not claiming "transmission media", as alleged in the rejection. Rather, as pointed out above, the claim preamble actually reads: "*A computer-readable medium tangibly embodying a program of recordable, machine-readable instructions executable by a digital processing apparatus to perform a computer-implemented method of*"

Accordingly, Appellants respectfully submit that, to the extent this wording is construed as being related to a transmission of the program, as the Examiner seems to do for this rejection, the plain meaning of the language would require a "computer-readable medium tangibly embodying the program of recordable, machine-readable instructions", for purpose of determining infringement (as well as the issue of statutory subject matter). Whether or not the transmission process by itself is sufficient to establish statutory subject matter is still unknown, but it is clear that, if a tangible medium results from the transmission, then a cause for infringement clearly would exist. Again, it is noted that the plain meaning of the claim language itself does not claim a "transmission", and it is the Examiner that imports this interpretation into the claim language, nor is there any attempt to claim "energy", the typical basis used by Examiners to reject this language.

Third, Appellant submits that the wording of the claim is directed to a "program of recordable, machine-readable instructions" and, as such, is clearly directed to a process, one of the four categories specifically identified in 35 USC §101 as statutory subject matter. The statute does not exclude a process that has been defined via a mechanism that includes a transmission of some sort.

Therefore, Appellants respectfully submit that these claims do indeed address statutory subject matter and, to the extent that it is considered to be related to a transmission of some sort, the plain meaning of the claim language precludes the interpretation that the transmission itself is being claimed.

Appellant, therefore, respectfully requests that the Board reverse this rejection, particularly since statutory subject matter is a question of law, not a question of fact, and Docket YOR920010315US1 (YOR.292)

would be reviewed *de novo* by the Court, should such need ever arise in this specific application. In other words, as a question of law, the Examiner's opinion would not be given deference by the Court in its own review of this issue.

ISSUE 2: THE ENABLEMENT REJECTION

Appellant adds nothing more to statement in his Brief, except to again point out that the claim language does not imply simultaneously using/not-using hypertext links.

ISSUE 3: THE OBVIOUSNESS REJECTION FOR CLAIMS 2-10, 22, 24-32, 44, 45, AND 47-51, BASED ON FOX, FURTHER IN VIEW OF EGENDORF

Appellant points out that even the Examiner's characterization in the rejection indicates that Fox uses only keywords in the search query itself. This characterization indicates that an element is missing in the prior art reference, since the claimed invention derives an N-dimensional space from words within all the documents of the database, rather than keywords within a specific query.

Because of this missing element, the prior art evaluation fails to establish a *prima facie* rejection.

The advantage of the method of the present invention is that document affinity is established in the present invention within the database as a whole. The affinity of documents is not based upon the input query.

The practical significance of this difference is that the present invention will indicate document affinity regardless of the choice of keywords of a specific query. In a document affinity based upon keywords of the query, the only documents returned will be those having the query keywords, so the documents returned depend upon the choice and form of the query keywords.

In contrast, in the present invention, documents surrounding the location that the user is placed based upon a query will include related documents that do not necessarily have any of the query keywords. In other words, the present invention provides an affinity based upon overall contents of the documents, not specific keywords used in a query.

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ISSUE 4: THE OBVIOUSNESS REJECTION FOR CLAIMS 11-17 AND 33-39, BASED
ON FOX/EGENDORF, FURTHER IN VIEW OF EGGER

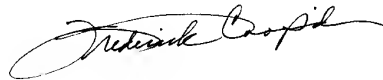
Appellant adds nothing more to arguments in his Brief.

CONCLUSION

In view of the foregoing, Appellant submits that claims 2-17, 22, 24-39, 44, 45, and 47-51, all the claims presently pending in the application, are clearly directed to statutory subject matter, are clearly enabled, are patentably distinct from the prior art of record, and are in condition for allowance. Thus, the Board is respectfully requested to remove all rejections of claims 2-17, 22, 24-39, 44, 45, and 47-51.

Please charge any deficiencies and/or credit any overpayments necessary to enter this paper to Assignee's Deposit Account number 50-0510.

Respectfully submitted,



Dated: January 10, 2008

Frederick E. Cooperrider
Reg. No. 36,769

McGinn Intellectual Property Law Group, PLLC.
8231 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer Number: 21254